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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,700	09/19/2003	James M. Mathewson II	RSW920030197US1	1988

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EXAMINER

LAI, ANNE VIET NGA

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,700

Applicant(s)

MATHEWSON ET AL.

Examiner

Anne V. Lai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by **Ogasawara** (previously provided) or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Ogasawara** in view of **Chung** [US. 6,961,000].

In claims 1 and 11, **Ogasawara** discloses a method and a system for implementing the method of preparing information usable in theft detection using radio frequency identification ("RFID") technology, comprising steps of: reading, from an RFID tag affixed to each of one or more items presented for purchase, identifying information for that item (col. 5, l. 9-37); and storing the identifying information for each item on a receipt reflecting the presented items (e-receipt; col. 5, l. 42-49); the e-receipt is delivered in conjunction with a printed sales receipt (conventional paper receipt) to the purchaser once the items have been paid (col. 8, l. 38-42).

Chung specifies the e-receipt is adhesively attached to the printed sales receipt (col. 4, l. 66- col. 5, l. 11). It is clear for any one that the tag and the printed portion are at separated areas for printed data to be visible.

In claims 2-3, 12-13, **Ogasawara** discloses the e-receipt includes the same types of information associated with conventional paper receipt, such as identification

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information of the items and enumerated list if more than one item is presented for purchase (fig. 4; col. 8, l. 43-56).

In claims 4-5, 14-15, **Ogasawara** discloses stock-keeping unit identifier and Electronic-Product Code (PLU, SKU, UPC; fig. 4; col. 5, l. 9-67; col. 8, l. 33- col. 9, l. 15).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-10, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shanahan** (previously provided) in view of **Ogasawara**.

In claims 6 and 16, **Shanahan** discloses a method and a system for implementing the method of detecting potential theft using radio frequency identification ("RFID") technology, comprising steps of:

scanning a receipt for identifying information stored in a machine-readable form to reflect one or more items that were presented for purchase in a previous sales transaction;

searching, in an RFID tag affixed to each or one or more items possessed by a shopper who also possesses the receipt, to locate corresponding identifying information for each possessed item; and

concluding that selected ones of the items possessed by the shopper were not paid for if the identifying information located for the selected items is not detected by the scanning step (par. 0051).

Shanahan discloses the receipt is an e-receipt, **Ogasawara** teaches a receipt provided to the purchaser can be a printed sales receipt in conjunction with an e-receipt (smart card, IC card; col. 8, l. 38-42, col. 9, l. 17-19) at the time of purchase.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to replace the consumer carried electronic sales receipt of **Shanahan** with an IC tag affixed to a printed sales receipt of **Ogasawara** to provide more convenient by virtue of the tag small size so that more information can be securely stored and reproduced; the purchase verification is more convenient and reliable with both machine-readable and human eye readable; and evidently the tag is located at separate area with the printed data on the receipt for the printed data to be read.

In claims 7 and 17, since the receipt of **Shanahan** and **Ogasawara** combined containing an RFID tag affixed to a printed sales receipt, it would have been obvious scanning the e-receipt can be reading an electronic tag affixed to the printed sales receipt by virtue of its fast response by its communication ability.

In claims 8 and 18, **Ogasawara** discloses the identifying information read from an RFID tag affixed to the items presented for purchase is stored on the printed sales receipt at the time of purchase (col. 8, l. 38-42), and **Shanahan** teaches issuing an e-receipt at purchase [0049] and verifying identification information of items and receipt at the store exit [0051].

In claims 9-10 and 19-20, **Shanahan** and **Ogasawara** do not disclose the concluding step does not conclude that selected ones of the possessed items were not paid for if those selected ones were in the shopper's possession when the shopper entered an establishment in which a transaction represented by the receipt was conducted; however known business practice at many stores (Best Buy, Costco, etc.) keep and remember items that are previously purchased by the shopper when he or she enters the store such that when the shopper arrives at the store exit check area, the receipt is checked against newly purchased items only so that the comparing and the concluding steps do not apply to the remembered items. Since this method of practice is known in manual scanning and theft checking stores, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to not include the shopper's previously owned items with the items to be checked (for example, write on the RFID tag affixed to the item, data indicating the item has been paid for).

5. The rejection to claims 21-25 are similar to the rejection to the method and the system for detecting theft of claims 1-5 and 11-15 with a reason that to make the system function automatically in a store equipped with computer, it would have been obvious to one having ordinary skill in the art at the time of the invention was made; a computer program product is obviously being implement.

6. The rejection to claims 26-30 are similar to the rejection to the method and the system for detecting theft of claims 6-10 and 16-20 with a reason that to make the system function automatically in a store equipped with computer, it would have been

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obvious to one having ordinary skill in the art at the time of the invention was made a computer program product is obviously being implement.

Response to Arguments

7. Applicant's arguments filed on 5/15/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Shannahan and Ogasawara fail to teach "the stored identification is stored in a first area of the printed sales receipt that is separate from a second area of the printed sales receipt in which the conventional itemized purchase list is printed"; the examiner disagrees. Ogasawara teaches an RFID tag (e-receipt) is delivered in conjunction with a printed sales receipt (conventional paper receipt) to the purchaser once the items have been paid (col. 8, l. 38-42; see office action above). It is evident to any one that for the printed data to be readable, the tag and the printed portion must be posted at separated areas. A reference of **Chung** also shows that the RFID smart tag is adhesively attached to the printed sales receipt; it is in common sense that the tag should not cover the printed area; otherwise one does not need to provide the printed receipt to the customer.

8. The Declaration of Fact Under 37 C.F.R. 1.131 has been considered for the July 16, 2003 priority; the reference of Hanna has been withdrawn.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schultz discloses a printed sales receipt (physical receipt) generated at point of sale (POS) comprises a transaction identifier in machine-readable form (bar code) locating in separated areas (fig. 15, [0076]). [US. 2002/0188561]

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne V. Lai whose telephone number is 571-272-2974. The examiner can normally be reached on 9:00 am to 6:30 pm, Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hofsass Jeffery can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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